

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, DALE BLACKSON,
BOB A. CICHON, JOSEPH C. ESS, MARK A. MOALES,
DAVID W. WEIS, MARK D. SMITH, and JAMES CHURCH

Appeal 2008-1626
Application 09/193,564
Technology Center 3600

Decided: August 18, 2008

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal controls an automated transaction machine that includes a computer and an associated memory. Software executing in the computer retrieves data via a hypertext transfer protocol ("HTTP") server and stores the data in the memory. (App. Br. 3.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method comprising:

(a) providing a plurality of HTTP records accessible through an HTTP server, wherein at least one record includes data corresponding to operating data, wherein the operating data is operative to control operation of an automated transaction machine;

(b) accessing the record data through the server with a computer in an automated transaction machine; and

(c) loading data corresponding to the operating data in a memory of the machine.

C. REJECTIONS

Claims 1-4, 7, 8, 10-14, and 17-20 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,706,442 ("Anderson"). Claims 5, 6, 9, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Anderson and U.S. Patent No 5,933,816 ("Zeanah"). "Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween." *Ex parte Katsukawa*, No. 2007-0732, 2007 WL 3043602 at *2 (BPAI 2007).

II. AUTOMATED TRANSACTION MACHINE

The Examiner finds that "[a]ccessing a record data through the server with a computer in an automated transaction machine" (Ans. 10) "is disclosed by Anderson in col 2 . . . lines 33-39" (*Id.*) The Appellants argue that "Anderson does not teach an 'automated transaction machine'" (4th Reply Br.¹ 19.) Therefore, the issue is whether Anderson discloses an automated transaction machine.

A. CLAIM CONSTRUCTION

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). Here, the Appellants' Specification (p. 1) explains that "[f]or purposes of this disclosure an . . . automated transaction machine shall encompass any device which carries out transactions including transfers of value."

B. ANTICIPATION AUTHORITIES

"[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371-72 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). "A reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular*

¹ We rely on and refer to the Fourth Reply Brief in lieu of the first three reply briefs, because the latter were defective. We have not considered the first three reply briefs in deciding this appeal.

art and be in possession of the invention." *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962)). Of course, anticipation "is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 n.11 (Fed. Cir. 1986)). "An anticipatory reference . . . need not duplicate word for word what is in the claims." *Standard Havens Prods. v. Gencor Indus.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

C. FINDINGS OF FACT

Here, the part of Anderson cited by the Examiner discloses that "[c]lient components and server components work in concert to provide timely financial information to users of an on-line financial information system built using Conductor" (col. 2, ll. 33-36), i.e., "[t]he Conductor System Architecture" (*Id.* l. 20.) Although the reference does not call its client component an "automated transaction machine" as in the claims, it discloses that the component "supports a suite of on-line financial services from various financial services providers" (col. 1, ll. 48-49) "includ[ing] . . . checking and bill paying." (*Id.* ll. 50-51.) We find that a skilled artisan knows that checking or bill paying transactions involve transfers of value. Because Anderson's client components support transactions involving transfers of value, moreover, we agree with the Examiner's finding that the reference teaches an automated transaction machine.

III. DATA

The Examiner finds that "obtain[ing] and manipulat[ing] financial information" (Ans. 10) "is disclosed by Anderson in col 2, lines 21-47" (*Id.*) The Appellants admit that the reference's "system permits client components and servers to work in concert to provide access to financial information" (Br. 5), but argue that "Anderson's 'financial information' doesn't constitute operating instructions for controlling operation of an automated transaction machine." (4th Reply Br. 8.) Therefore, the issue is whether Anderson discloses data.

A. CLAIM CONSTRUCTION

"[O]ur reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art." *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (citing *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004)), *aff'd*, 191 Fed. Appx. 959 (Fed. Cir. 2006). "[W]hen descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability." *Mathias*, 84 USPQ2d at 1279 (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)).

Furthermore, "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed.Cir. 2003).

Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Here, claim 1 recites in pertinent part the following limitations:
"*operating data is operative to control operation of an automated transaction machine . . .*" (Emphases added.) Because the term "operating" "cannot alter how the process steps are to be performed to achieve the utility of the invention" *Mathias*, 84 USPQ2d at 1279, we view it as nonfunctional descriptive material. Therefore, the term is not entitled to patentable weight. Because the clause "operative to control operation of an automated transaction machine" merely states an intended use or purpose for the data, moreover, the clause also is not entitled to patentable weight.

Similarly, claim 7 recites in pertinent part the following limitations:
"*transaction machine operating data . . .*" (Emphasis added.) Because the clause "transaction machine operating" cannot alter how the functions are to be performed to achieve the utility of the invention or merely states an intended use or purpose for the data, moreover, it is not entitled to patentable weight. Giving claims 1 and 7 their broadest, reasonable construction, therefore, the limitations merely require data.

B. FINDINGS OF FACT

Because the reference provides access to financial information, which constitutes data, we agree with the Examiner's finding that Anderson discloses data.

IV. LOADING DATA INTO MEMORY

The Examiner finds that "loading data corresponding to operating data in a memory of the machine" (Ans. 11) is "disclose[d] . . . in col 4, lines 45-67, fig 2 databases or memory." (*Id.*) The Appellants argue that "these databases do not constitute a memory of an automated transaction machine." (4th Reply Br. 12.) Therefore, the issue is whether Anderson loads data into a memory of the automated transaction machine.

A. FINDINGS OF FACT

As aforementioned, the Appellants admit that Anderson's "system permits client components and servers to work in concert to provide access to financial information" (Br. 5.) Furthermore, the reference explains that "customers have a need to see the financial data" (col. 1, l. 43) and that "the financial information obtained electronically may be downloaded directly to customers' personal computers for further processing." (*Id.* ll. 52-54.) We find, moreover, that a skilled artisan knows that viewing data via a computer involves loading the data into a display memory buffer *inter alia* and that downloading data to a computer implies downloading the data into a memory of the computer.

B. ANALYSIS

Because Anderson downloads financial information to a customer's computer, we agree with the Examiner that Anderson loads data into a memory of its machine. Therefore, we affirm the rejection of claims 1, 2, 4, 7, 11, and 14.

V. LIMITATIONS NOT ADDRESSED BY EXAMINER

Regarding claim 3, the Appellants argue, "Anderson further does not disclose or suggest loading operating data in a memory of an ATM responsive to instructions in a document." (App. Br. 15.) Regarding claims 8 and 13, the Appellants argue, "Anderson does not teach doing anything in response to a change in condition of a transaction function device of an ATM." (4th Reply Br. 21.) Regarding claim 10, the Appellants argue that the Examiner "admits that Anderson fails to teach or suggest 'applets'" (*Id.*) Regarding claim 13, the Appellants argue that "Anderson does not teach software which is operative to cause a sheet dispenser to operate in response to transaction machine operating instructions included in a document accessed with a browser." (*Id.* 23.) Therefore, the issue is whether the Examiner has presented a *prima facie* case of unpatentability.

A. AUTHORITIES

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

B. ANALYSIS

Here, because he has not addressed the specific limitations argued by the Appellants, the Examiner has not presented a *prima facie* case of unpatentability. Therefore, we reverse the rejection of claims 3, 8, 10, 12, and 13.

VI. RESPONSIVELY OPERATING A DEVICE

The Examiner finds that "Anderson discloses . . . operating the at least one transaction function device of the automated transaction machine responsive to the operating data (see., fg 2, col 4, lines 45-67, databases or memory)." (Ans. 7-8.) The Appellants argue that "Anderson further fails to teach operating a transaction function device of an ATM responsive to operating data loaded in a memory of the ATM" (4th Reply Br. 25.) Therefore, the issue is whether the Examiner has shown that Anderson

operates at least one transaction function device of the automated transaction machine responsive to data loaded into the automated transaction machine's memory.

A. CLAIM CONSTRUCTION

Here, in contrast to claims 1 and 7, claim 17 recites in pertinent part the following limitations: " loading data corresponding to the operating data in a memory of the automated transaction machine; and operating the at least one transaction function device of the automated transaction machine responsive to the operating data."

B. FINDINGS OF FACT

As aforementioned, we agree with the Examiner that the client computers of Anderson constitute automated transaction machines. Although the reference's "databases 28, 34, 40 within [its] distributed environment" (col. 4, ll. 49-50) are memories, however, we agree with the Appellants that "these databases do not constitute a memory of an automated transaction machine." (4th Reply Br. 12.) More specifically, rather than being components of the client components, Anderson describes the databases as "server components." (Col. 4, ll. 47-48.)

C. ANTICIPATION ANALYSIS

For the aforementioned reasons, the Examiner has not shown that Anderson operates at least one transaction function device of the automated transaction machine responsive to data loaded into the automated transaction

machine's memory. Therefore, we reverse the rejection of claim 17 and of claims 18-20, which depend therefrom.

VII. COMBINING TEACHINGS OF ANDERSON AND ZEANAH

The issue is whether the Appellants have shown error in the Examiner's reason for combining teachings of Anderson and Zeanah.

A. AUTHORITIES

Just as "[i]t is not the function of [the U.S. Court of Appeals for the Federal Circuit] to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art" *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991), "it is not the function of this Board to examine claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *Ex parte Post*, No. 2005-2042, 2006 WL 1665399 at *4 (BPAI 2006). Furthermore, a "reply by the applicant or patent owner [to a rejection] must . . . distinctly and specifically points out the supposed errors in the examiner's action The reply must present arguments pointing out the specific distinctions believed to render the claims . . . patentable over any applied references." 37 C.F.R. § 1.111(b).

B. FINDINGS OF FACT

Here, the Examiner specifically explains why it would have been obvious at the time of the invention to a person of ordinary skill in the art to have combined teachings of Anderson and Zeanah to arrive at the claimed subject matter. To wit, he offers the following finding and conclusion.

[I]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the on-line financial services of Anderson by including an applet as taught by Zemannah [sic] because it would provide a delivery system and method that are capable of supporting existing remote devices (see., Zeanah, col 5, lines 1-3).

(Ans. 6-7.) The Appellants respond that "[t]he rejections also do not identify a valid reason why a person having ordinary skill in the art would have combined the alleged features in the manner claimed" (4th Reply Br. 27.)

C. ANALYSIS

Without specifically addressing the Examiner's finding, the Appellants' response amounts to a general allegation that the claims define a patentable invention. It shows no error in the Examiner's reason for combining teachings of Anderson and Zeanah.

VIII. COMBINED TEACHINGS OF ANDERSON AND ZEANAH

Regarding claims 5 and 9, the Appellants argue that "neither reference discloses nor suggests that such operating data includes applets" (4th Reply Br. 28) and that "neither reference discloses nor suggests that such ATM operating data includes an applet" (*id.* 29), respectively. Regarding claim 6,

they argue that "neither reference discloses nor suggests that such operating data includes instructions executable by a computer to access applets." (*Id.* 28.) Regarding claims 15 and 16, the Appellants argue that "neither reference discloses nor suggests that such transaction machine operating data includes Active-X code" (*id.* 29) and that "neither reference discloses nor suggests that such transaction machine operating data includes JAVA® code, (*id.* 30), respectively. Therefore, the issue is whether the Appellants have shown error in the Examiner's findings about what the combined teachings of Anderson and Zeanah would have suggested to one of ordinary skill in the art.

A. AUTHORITIES

"The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art." *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *Keller*, 642 F.2d at 425). In determining obviousness, furthermore, a reference "must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." *Id.*

B. FINDINGS OF FACT

Here, the Examiner rejects claims 5, 6, 9, 15, and 16 under § 103(a) as obvious over the combined teachings of Anderson and Zeanah. (Ans. 6-7.)

C. ANALYSIS

Because the Appellants' arguments attack the two references individually, they cannot show error in the Examiner's findings about what the combined teachings of Anderson and Zeanah would have suggested to one of ordinary skill in the art. Therefore, we affirm the rejection of claims 5, 6, 9, 15, and 16.

IX. ORDER

In summary, the rejections of claims 1, 2, 4-7, 9, 11, and 14-20 are affirmed. The rejection of claims 3, 8, 10, 12, and 13, however, is reversed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii).

Accordingly, our affirmance is based only on the arguments made in the Appeal Brief and Fourth Reply Brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

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No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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